

REMARKS

Claims 1-12 and 17-18 are pending. By this Amendment, claim 1 is amended and no claims are canceled or added.

Claim 1 is amended to recite "proliferative disorder" in place of "rare event." No new matter has been added to the claims as a result of the foregoing amendment.

In view of the foregoing amendments to the claims, reconsideration and withdrawal of the rejections are respectfully requested.

35 U.S.C. § 112

Claims 1-12, 17, and 18 are rejected under 35 U.S.C. § 112, ¶ 2 as indefinite, the rejection asserting that "rare event" recited in claim 1 lacks antecedence. Applicant respectfully traverses this rejection. However, in order to advance the prosecution of this Application, claim 1 is amended to recite "proliferative disorder" in lieu of "rare event." By amending the pending claims to recite "proliferative disorder" in place of "rare event," Applicants do not concede that the former limitation is indefinite and reserve the right to prosecute claims having "rare event" in subsequent continuing applications. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

35 U.S.C. § 102

Claims 1-3, 5, 6, 9-12, 17, and 18 are rejected under 35 U.S.C. § 102(e) as anticipated by US 5,962,237 ("Ts'o et al."). Applicants respectfully traverse this rejection. Claim 1 recites, *inter alia*, "wherein the binding agent is bound to a magnetic bead." By contrast Ts'o et al. recites a Collection II fluid containing primary antibodies that is then incubated with secondary antibodies that are bound to supports such as magnetic beads.¹ Thus, in Ts'o et al. a binding

¹ Ts'o et al. beginning at column 3, line 30 ("FIG. 4 schematically depicts one exemplary embodiment of the negative selection process of the present invention. The Collection II fluid is incubated with one or more primary antibodies to the non-rare cells, e.g., antibodies specific to white blood cell and/or red blood cell antigens. The Collection II fluid containing the primary antibodies is then incubated with secondary antibodies that are bound to supports such as magnetic beads. The primary antibodies bind to the non-rare cells, and the secondary antibodies (that are bound to the beads) bind to the primary antibodies. Accordingly, the removal of the beads from the fluid provides a fluid enriched with the rare cells, referred to below as the Collection III fluid.").

agent bound to a magnetic bead is never bound to cells in the source expressing the cell specific marker. Claim 1 further recites “processing the plurality of images to identify the proliferative disorder, which is neither disclosed nor suggested by Ts’o et al. Consequently, claim 1 is not anticipated by Ts’o et al. The other rejected claims depend directly or indirectly from Ts’o et al. Accordingly, the other rejected claims are not anticipated by Ts’o et al. as well. Because the rejected claims are not anticipated by Ts’o et al., reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-4, 6-12, 17, and 18 are rejected under 35 U.S.C. § 102 (e) as anticipated by US 6,365,362 (“Terstappen et al. Claim 1 recites, *inter alia*, “automatically scanning the microscope slide at a plurality of coordinates using a microscope; automatically obtain a plurality of images at locations on the microscope slide that comprise the enriched sample; and processing the plurality of images to identify the proliferative disorder.” The undersigned can find no portion of Terstappen et al. which either discloses or suggests these limitations. Consequently, claim 1 is not anticipated by Terstappen et al. The other rejected claims depend directly or indirectly from claim 1. Thus, the other rejected claims are not anticipated by Terstappen et al. as well. Because none of the rejected claims are anticipated by Terstappen et al., reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Application No. 10/618,577

Respectfully submitted,

A handwritten signature in cursive script that reads "Wm. Larry Alexander".

Wm. Larry Alexander, Ph.D.

Registration No. 37,269

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5757